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Docket 81254F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Joseph A. Manico, et al

FOLDED INTEGRAL
COMPOSITE IMAGE PRODUCT
AND METHOD OF MAKING

Serial No. US 09/593,645

Filed 13 June 2000

Commissioner for Patents
Box AF
Washington, D.C. 20231

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the
above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief
filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate
copy of this letter is enclosed.

Respectfully submitted,

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Enclosures

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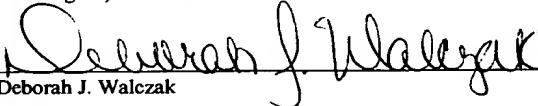
Serial No. US 09/593,645

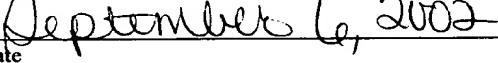
Filed 13 June 2000

Group Art Unit: 3722

Examiner: M. Henderson

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, Before the Board of Patent Appeals and Interferences, Washington, D.C. 20231.


Deborah J. Walczak


Date

Commissioner for Patents
Box AF
Washington, D.C. 20231

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192



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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-34 and 44-47 which was contained in the Office Action mailed April 9, 2002.

A timely Notice of Appeal was filed July 8, 2002.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

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Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-34 and 44-47 have been rejected and are appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

All Amendments have been entered and the claims stand as indicated in Appendix I.

Summary Of The Invention

The present invention is directed to a dual sided integral composite image product. In particular, to an image product 10 comprising a first substrate 12 having a separate image layer upon which images 16 may be provided. A second support substrate 14 also having an image layer upon which image 16 may be provided. The first and second substrates 12, 14 are secured so as to form a dual sided integral composite image product to form the image product 10. The image product 10 is provided with a fold line 18 for allowing folding or unfolding of the album page which allows easy viewing of the entire image.

Issues For Review By The Board

The following issues are presented for review by the Board of Patent Appeals and Interferences:

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1-33 and 44-47 are unpatentable under 35 USC § 103(a) as being unpatentable over Manico et al. (US Patent 5,791,692) in view of Hambright (US Patent 6,164,859).

2. Whether claim 34 is unpatentable under 35 USC § 103(a) as being unpatentable over Manico et al. in view of Hambright, in view of Fabel (US Patent 5,836,622).

Grouping Of Claims

Group 1: Claims 1-28 stand together as a group;

Group 2: Claims 29-34 stand together as a group;

Group 3: Claims 44-47 stand together as a group.

Arguments

The Rejection

A. Rejection under 35 USC §103(a) of Claims 1-28 over Manico et al in view of Hambright.

The Examiner has finally rejected claims 1-33 and 44-47 under 35 USC § 103(a) over Manico et al. in view of Hambright.

The Examiner acknowledges that the Manico et al. reference does not teach or suggest providing the image product with fold lines as taught and claimed by applicant. The Examiner goes on to further recite that the Hambright reference provides the missing element. In particular, the Examiner states that Hambright discloses that Figs. 1-8, and image product 14 comprising a fold line 104 in which the image product can be folded in numerous sections and wherein the image product also contains a cover or free standing product for holding the image product, and an attaching member consisting of a leaf to secure the image product to the cover and an opening in the leaf to secure the leaf to the ring. In

this regard, applicant respectfully submits that the Hambright reference is of little relevance to the present invention. First, the image product 14 of Hambright is not an image product but is a holder designed to receive items 16. See column 3, lines 22-30. In addition, the album page of Hambright is a main sheet 60 which is made of a relatively thin and flexible transparent material. See column 3, lines 60-63. Thus, it is clear that the items 16 that are placed within the holder 14 are designed to be viewed the product. Thus, the product 14 is not an image product but simply a holder for the holding of articles which are to be viewed through the holder. In the Final Rejection the Examiner has stated that the image product of Hambright is relied upon for disclosing an image product "in its broadest interpretation" which may be folded into numerous sections. Independent claims 1, 10, and 20, all include the limitation of the substrate having an image layer. This image layer is an integral part of the image product. As set forth on page 6, lines 2-8, the present invention is directed to an image product having first and second image emulsion layers thereon upon which images may be provided. Thus, the image product has images integrally formed thereon. This is in complete contrast to the Hambright reference which is a holder in which image products may be placed by such as prints and designed to be viewed. It is the holder of Hambright that is folded, not the image product. It is clear that the limitation of the claims are to be read in light of the specification and given to broadest reasonable interpretation (see MPEP 2111) *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ 2d 1464, 1468 (Fed. Cir 1999). Clearly, an image product in accordance with the present invention is not directed to a holder through which images may be viewed, but instead is directed to the actual product on which images are integrally formed.

Further, Hambright teaches away from the present invention as it provides a holder for holding of articles in contrast with the present invention which is directed to the image product itself. Further, there is no motivation for combining the Hambright reference with Manico et al. as suggested by the Examiner. Obviousness can not be demonstrated by combining prior art references unless there is a suggestion for doing so, found either in the references themselves or knowledge generally available to one of ordinary skill in the art. *In re Jones*, 958 F. 2d. 347, 351, 21 USPQ 2d. 1941, 1943-44(Fed. Cir. 1992); see also *In re Geiger*, 815 F. 2d. 686, 688, 2 USPQ 2d. 1276-1278 (Fed. Cir. 1987). Applicant respectfully submits that no such teaching is provided by the cited references. As previously noted, the Hambright reference is directed to a holder for the holding of image products to avoid the necessity of folding the image

product. This is in complete contrast to the present invention wherein the image product is actually designed to be folded. Thus, there would be no motivation to make the suggested combination. Further, it is respectfully submitted that Hambright teaches away from the combination suggested by the Examiner. Hambright avoids the folding of the image product. Applicant respectfully submits that the Examiner has used hind sight in an attempt to piece mail applicants' invention.

B. Rejection under 35 USC §103(a) of Claims 29-34 over Manico et al in view of Hambright.

Claim 29 is an independent claim upon which claims 30-34 depend at least ultimately. Claim 29 is directed to a image product comprising a composite cover having a first support substrate having a separate image layer and a second substrate having a separate image layer on which images are formed. The image product includes at least one leaf having a first support substrate having a separate image layer and a second support structure having an image layer thereon. In addition, there is provided an attaching member for securing the leaf to the cover. This embodiment is better illustrated by reference to Figs. 7 and 8 of the instant application. In particular, the cover 62 is provided in which the leaf for attaching of the image product 60 is illustrated in Fig. 5. Thus, it can be seen that there is provided in combination for both the cover and the leaf are provided with images thereon and attaching means. In this embodiment, it is both the cover and leaf that both have image retaining layers. In none of the references cited by the Examiner, does it teach or suggest this. As previously noted, the Hambright reference merely discloses a holder that is substantially transparent for viewing of images therein. Thus, it could not teach or suggest that the cover has images in addition to the image products that are attached to the cover. Accordingly, it is respectfully submitted that claim 29 and its dependent claims are not taught or suggested by the prior art.

C. Rejection under 35 USC §103(a) of Claims 44-47 over Manico et al in view of Hambright.

Group 3 includes three independent claims 44, 45 and 47 including an image product which includes at least one supporting substrate having an image later thereon and at least one fold line. Thus, these independent claims are patentably distinct for the same reasons discussed with respect to the independent claims of Group 1. In addition, these independent claims include the additional feature of having attachment sections integrally formed with the first or second

substrate. This allows the substrate to be placed within a holder. There is no teaching or suggestion in the references cited of providing a folded image product having attachment means integrally formed therein as taught and claimed by applicant. The attachment means of Hambright are for the holder. The Manico reference does not teach or suggest the folding of the image product after it has been formed. Accordingly, the prior art clearly fails to teach or suggest the combination as taught and claimed by applicant. Nor is there any teaching or suggestion to make modifications to the product as taught and claimed by applicant. In summary applicant respectfully submits that these claims are patentably distinct over the references cited.

The Examiner also rejected claim 34 under 35 USC § 103(a) as being unpatentable over Manico et al. in view of Hambright and further in view of Fabel. Claim 34 is dependent upon independent claim 1 and is therefore patentably distinct for the reasons discussed with regard to the claims in Group 1.

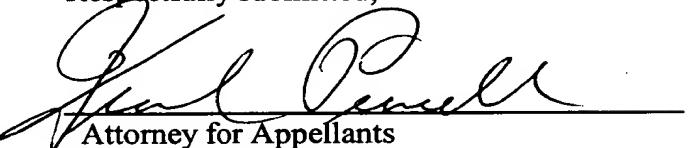
Summary

In summary, applicant respectfully submits that the claims in the present invention are patentably distinct over the prior art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-34 and 44-47.

Respectfully submitted,


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Enclosures

Appendix I - Claims on Appeal

1. A dual sided integral composite image product, comprising:
 - a first support substrate having a separate image layer thereon;
 - a second support substrate having separate image layer thereon,
second support substrate being secured to said first support substrate so as to form
said dual sided integral composite image product; said integral composite image
product having a fold line about which said integral composite image product may
be folded.
2. A dual sided integral composite image product according to
claim 1 wherein said integral composite image product has a plurality of fold
lines.
3. A dual sided integral composite image product according to
claim 2 wherein said plurality of fold lines allows for providing a Z type fold in
said integral image product.
4. A dual sided integral composite image product according to
claim 1 wherein said first and second substrates are made from a photographic
media.

5. A dual sided integral composite image product according to claim 1 wherein said first and second substrates are made from a photographic paper.

6. A dual sided integral composite image product according to claim 1 wherein said first and second substrates are made from a thermal media.

7. A dual sided integral composite image product according to claim 4 wherein said image layer comprises a photographic emulsion layer.

8. A dual sided integral composite image product according to claim 1 wherein said composite image product comprises a cover for holding at least one leaf.

9. A dual sided integral composite image product according to claim 1 wherein said composite image product comprises a free standing product.

10. A dual sided folded image product comprising;
a sheet having a first side and a second side, said first side having an image layer separate from said sheet, said sheet having two spaced fold lines which form a central section and a first side section and a second side section, said central section being positioned between said first and second side sections, said side sections being folded on said so that said image layer is exposed.

11. A dual sided folded image product according to claim 10
wherein said side sections substantially cover said central section.

12. A dual sided folded image product according to claim 11
wherein of said side sections having an end that is substantially about each other.

13. A dual sided folded image product according to claim 12
further comprising a fold line disposed substantially co-extensive with a line
formed by said ends of said side sections.

14. A dual sided folded image product according to claim 11
wherein each of said side sections having an end which overlaps each other.

15. A dual sided composite image product according to claim
10 wherein said sheet is made from a photographic paper.

16. A dual sided composite image product according to claim
10 wherein said sheet is made from a thermal media.

17. A dual sided composite image product according to claim
15 wherein said sheet includes a photographic emulsion layer.

18. A dual sided composite image product according to claim 10 wherein said composite image product comprises a cover for holding at least one leaf.

19. A dual sided composite image product according to claim 1 wherein said composite image product comprises a free standing product.

20. A dual sided image product comprising:
a support substrate having a first side and a back side, said first side having an image layer separate from said support substrate, said support substrate having at least one fold line about which said support is folded for forming said image product.

21. A dual sided integral composite image product according to claim 20 wherein said integral composite image product has a plurality of fold lines.

22. A dual sided integral composite image product according to claim 21 wherein said plurality of fold lines allows for providing a Z type fold in said integral image product.

23. A dual sided integral composite image product according to claim 20 wherein said first and second substrates are made from a photographic media.

24. A dual sided integral composite image product according to claim 20 wherein said first and second substrates are made from a photographic paper.

25. A dual sided integral composite image product according to claim 20 wherein said first and second substrates are made from a thermal media.

26. A dual sided integral composite image product according to claim 24 wherein said image layer comprises a photographic emulsion layer.

27. A dual sided integral composite image product according to claim 1 wherein said composite image product comprises a cover for holding at least one leaf.

28. A dual sided integral composite image product according to claim 20 wherein said composite image product comprises a free standing product.

29. An image product comprising:

a composite cover having a first support substrate having a separate image layer thereon, and a second support substrate having separate image layer thereon, said second support substrate being secured to said first support substrate so as to form said dual sided integral composite image product; said integral composite image product having a fold line about which said integral composite image product may be folded;

at least one leaf having a first support substrate having a separate image layer thereon, and a second support substrate having separate image layer thereon, said second support substrate being secured to said first support substrate so as to form said dual sided integral composite image product; and

an attaching member for securing said at least one leaf to said cover.

30. An image product according to claim 29 wherein a plurality of said at least one leaf is provided.

31. An image product according to claim 29 wherein said attaching member is secured to said cover.

32. An image product according to claim 31 wherein said attaching member comprises at least one ring.

33. An image product according to claim 32 wherein said at least one leaf includes at least one opening adapted to be secured to said at least one ring.

34. An image product according to claim 33 wherein at least one scored line is provided on said leaf in association with said opening for allowing the leaf to be installed or removed from said ring.

44. A dual sided integral composite image product, comprising:
a first support substrate having a separate image layer thereon;
a second support substrate having separate image layer thereon,
said second support substrate being secured to said first support substrate so as to form said dual sided integral composite image product; said integral composite image product having a fold line about which said integral composite image product may be folded;
an attachment section integrally formed with said first and/or second substrate.

45. An integral composite image product, comprising:
a first support substrate;
a second support substrate having separate image layer thereon,
said second support substrate being secured to said first support substrate so as to form said integral composite image product; said integral composite image

product having a fold line about which said integral composite image product may be folded;

an attachment section integrally formed with said first and/or second substrate.

46. A dual sided integral composite image product according to claim 45 wherein a plurality of fold lines are provided.

47. A image product, comprising:
a support substrate having a separate image layer thereon, said support substrate having a plurality of fold lines about which said image product may be folded; and
an attachment section integrally formed with substrate.

47. A image product, comprising:
a support substrate having separate image layer thereon, said support substrate having a plurality of fold lines about which said image product may be folded; and
an attachment section integrally formed with said first and/or second substrate.